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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,428	12/20/2004	Katrin Gisselhalt	1511-1036	6764
466 7590 03/09/2009 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			EXAMINER GILLESPIE, BENJAMIN	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 03/09/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/518,428

Applicant(s)

GISSELFALT, KATRIN

Examiner

BENJAMIN J. GILLESPIE

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Rabon Sergeant/
Primary Examiner, Art Unit 1796

Continuation of 3. NOTE: The proposed amendment sets forth limitations with respect to the definition of y that have not been set forth previously..

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' request for reconsideration has been considered, but is not persuasive.

The examiner would like to point out that the theoretical analysis of Flodin according to Flory has not been presented in a declaration, and therefore appears to be an unsubstantiated opinion. Furthermore, even if applicants submit a declaration explaining the merits of Flory, it is the examiner's position that Flory is not relevant in evaluating the polyurea-urethane of Flodin since Flory is drawn to condensation reactions of low molecular weight diols and dicarboxylic acids, not diisocyanate and polyester diol. Additionally, Flory provides no discussion regarding the effects of temperature and catalyst, which are relevant issues in the instant prima facie case of obviousness.

However, even if applicants maintain the theoretical analysis is relevant, it is the examiner's position that Flory holds no weight in overcoming the instantly presented prima facie case of obviousness. The final rejection mailed 11/21/2008 explains how example 4 satisfies all of the claimed limitations except a reaction temperature of 60C. With this understanding, the examiner pointed out how it would be obvious to modify the reaction temperature of example 4 from 70-80C to 60C based on column 4 lines 35-45 of Flodin. Applicants have not set forth any data or experimental showings that a reaction temperature of 60C is unobvious for example 4.

Instead applicants' theoretical comparatives are presented with the assumption that "all diisocyanate and all diol are mixed at once". With this understanding, the examiner would like to point out that applicants' theoretical analysis fails to provide a comparison with the closest prior art, i.e. the "dropwise" addition of polyesterdiol in example 4. Furthermore, it is the examiner's position that one of ordinary skill would reasonably expect dropwise addition of polyesterdiol in an excess of diisocyanate results in perfect-prepolymers. Dropwise introduction of polyesterdiol results in a relative "overload" of monomeric diisocyanate when compared to the newly introduced polyesterdiol - this increases the likelihood of diol + monomeric diisocyanate reaction.

Moreover, applicants state "it would have been further unobvious that a process of slow addition, drop by drop of diol to a bulk of diisocyanate at a temperature at or below 60C would give desired material properties with respect to toughness, elongation, and degradation", however this position is not persuasive since it has not been supported by any type of experimental data, and instead is based on an unsubstantiated opinion which can not be substituted for fact. In re Pike et al., 84 USPQ; In re Renstrom, 81 USPQ 390.

Finally, it is the examiner's position that because of applicants' assumed "mixed at once" vs. the relied upon "dropwise" method, as well as Flory failing to discuss diisocyanate + polyesterdiol, reaction temperature, and catalyst, it is the examiner's position that any theoretical analysis based on the teachings of Flory will be insufficient to overcome the current prima facie case of obviousness - each of these factors need to be addressed before one can clearly establish the current case of prima facie obviousness has been overcome.